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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,528	09/26/2003	Sylvia Monsheimer	236706US6	6515
22850	7590	11/19/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER COZART, JERMIE E	
			ART UNIT 3726	PAPER NUMBER
			NOTIFICATION DATE 11/19/2008	DELIVERY MODE ELECTRONIC

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/670,528
Filing Date: September 26, 2003
Appellant(s): MONSHEIMER ET AL.

James J. Kelly, Ph.D.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/31/08 appealing from the Office action mailed 2/1/08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,596,122	SAVITSKI et al.	7-2003
6,155,302	FISCHERKELLER et al.	12-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 10, 13, 17, 20, 24, 27, 31, 34, 38, 40, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Savitski et al. (6,596,122) in view of Fischerkeller et al. (6,155,302).

Savitski discloses a composite part such as a pipeline (20, 30, 40), wherein the pipeline can be configured in a variety of different sizes which therefore leads to other inherent uses (i.e. fuel line). The pipeline comprises a transmissive adaptor (40) which both a plastic pipe (20) and another plastic part (30) which are essentially not transmissive. The adaptor (40) is a sleeve. The adaptor and the plastic pipe and the other plastic part are welded together by using a laser (col. 6, lines 35-45), and it is apparent that the parts are welded to one another along their periphery. The other plastic part (30) is a pipe. The pipeline of Savitski can be considered is essentially a hydraulic fluid line and can also be considered a motor vehicle pipeline. *See column 6, line 23 – column 10, line 3, and figures 1-3 for further clarification.*

Regarding the above cited rejections, *MPEP Section 2113 [R-1]* **Product By Process Claims**, states that "[T]he lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a

product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

Savitski, however, does not disclose the other plastic part having at least one nipple which is provided for the connection to the pipe, wherein the nipple is provided on the outside with a profile.

Fischerkeller discloses providing another plastic part (11) with at least one nipple (10) which is use for the connection to the pipe (20) wherein the nipple (10) is provided on the outside with a profile, the plastic part (11) and pipe (20) also employ the use of an adaptor (22) to aid in the assembly of the pipe and part with respect to one another. In addition, the nipple (10) and adaptor (22) can be subjected to heat during assembly (col. 2, line 66 – col. 3, line 8). *See column 1, line 66 – column 2, line 24, and figure for further clarification.*

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the other plastic part of Savitski with at least one nipple wherein the nipple is provided on the outside with a profile, in light of the teachings of Fischerkeller, in order to connect the other plastic part to the pipe. Such a modified construction of the Savitski pipes would enable pre-assembly of the pipes prior to laser welding, facilitating their alignment and providing a more reliable connection.

(10) Response to Argument

Appellants state that one would not look to Fischerkeller et al. to modify Savitski to incorporate a nipple provided on the outside profile as claimed because Savitski et al. explicitly discloses a way to connect the component parts so there is no need for a nipple as claimed.

In response to Appellants' statement that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the base reference to Savitski as explained in detail above connects the pipe and other plastic using an adaptor and joins all the parts together by laser welding. Fischerkeller discloses connecting a pipe (20) and the other plastic part (11) wherein the other plastic part is provided with a nipple (10) being provided on the outside with a profile and the pipe is provided with an adaptor (22) that facilitates the joining of the pipe and part to one another. Although Savitski uses welding to in combination with the adaptor to join the pipe and plastic pipe to one another, the specification of Savitski does not exclude the possibility of adding supplemental retention features to either the pipe or other plastic pipe in combination with welding or heating. The teachings of Fischerkeller in no way destroy the teachings of Savitski, and in fact the arrangement/connection of

Fischerkeller achieves reliable sealing (col. 2, lines 60-66) even if the pipe (20) should widen after being heated since the adaptor (22) is prestressed to provide significant compressive pressure to the pipe (20) and plastic part (11), and thereby maintains the reliable sealing previously mentioned. Therefore, the teachings of Fischerkeller provide the necessary motivation for one of ordinary skill in the art at the time of invention to provide the other plastic part of Savitski with at least one nipple because during a heating stage the connection of the components does not become loose or untight since they expand identically and during a cooling stage they shrink identically even though a nipple is employed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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